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In re Application of
MIHAN et al.
Application No.: 10/522,574
PCT No.: PCT/EP03/08900
Int. Filing Date: 11 August 2003
Priority Date: 13 August 2002
Attorney Docket No.: LU6046
For: MONOCYCLOPENTADIENYL COMPLEXES

DECISION UNDER
35 U.S.C. 371 and
MERGING APPLICATION FILES

The above-identified application is before the PCT Legal Office for matters arising under 35 U.S.C. 371.

BACKGROUND

On 11 August 2003, applicant filed international application No. PCT/EP03/08900, which claimed priority of an earlier international application filed 13 August 2002 and designating the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 March 2004. The deadline for entering the U.S. national stage to 30 months or as of midnight on 13 February 2005.

On 28 January 2005, applicant filed, through the law firm of Keil & Weinkauff, a transmittal letter for entry into the national stage in the United States (Form PTO-1390) which was accompanied by, *inter alia*, the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and an declaration identifying PCT/EP03/08900. The submission, identifying PCT/EP03/08900, was assigned U.S. application number: 10/522,574. On 1 November 2005, a declaration, identifying PCT/EP03/08900 and executed by the joint inventors, and in compliance with 37 CFR 1.497(a) and (b) was submitted. On 23 March 2006, a Notification of Acceptance was mailed to applicant identifying PCT/EP03/08900 and indicating a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 1 November 2005.

After the thirty month period for entry into the national stage and without a petition to revive, on 22 February 2005, applicant, through the law firm of Novak Druce DeLuca & Quigg, filed another Transmittal Letter referencing PCT/EP03/08900 but with an incorrect title of invention, requesting entry into the national stage in the United States. The communication was accompanied by, *inter alia*, authorization to charge fees to applicant's credit card account. These papers were assigned U.S. application number 10/525,223. On 22 February 2005, an executed declaration was also filed in the national stage application, identifying PCT/EP03/08900. On 20 October 2005, a Notification of Acceptance was erroneously issued identifying PCT number PCT/JP03/10076.

DISCUSSION

As is evident from the above recited facts, applicant submitted papers to enter the national stage for the same international application on 28 January 2005 and 22 February 2005. The end result for an international application designating the United States of America is a single U.S. national stage application.¹ Therefore, assigning a second U.S. application number arising from PCT/EP03/08900 was improper. Thus, the Notification of Acceptance mailed on 20 October 2005 directed to 10/525,223 is hereby VACATED.

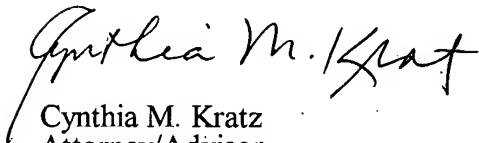
The papers filed on 22 February 2005, assigned application no. 10/523,223, will be merged in application file 10/522,574. Application no. 10/522,574 is considered the U.S. national stage application arising from PCT/EP03/08900. The Notification of Acceptance mailed on 24 March 2006 in 10/522,574 remains in effect.

CONCLUSION

Application no. 10/522,574 is considered the U.S. national stage application arising from PCT/EP03/08900. Applicant is advised to use U.S. application no. 10/522,574 in all future correspondence. The Notification of Acceptance mailed on 24 March 2006 in 10/522,574 remains in effect.

With regard to application no. 10/523,223, the papers filed on 22 February 2005 will be merged into U.S. application file 10/522,574. The Notification of Acceptance mailed on 20 October 2005 directed to 10/525,223 is hereby VACATED. The national stage fees paid in 10/523,223 will be refunded to applicant.

The application will be forwarded to Art Unit 1755 for examination in due course.


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¹ 35 U.S.C. 363 states:

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in 102(e) of this title. (emphasis added)

Further, 35 U.S.C. 371(b) states:

(b) Subject to subsection (f) of this section, the national stage shall commence with the expiration of the applicable time limit under article 22(1) or (2), or under article 39(1)(a) of the treaty. (emphasis added)

The language of 35 U.S.C. 363 and 371 refers to the national stage of the PCT in the singular only, and thus only one (1) national stage application in the U.S. may develop from an international application.